

REMARKS

This amendment responds to the office action mailed February 20, 2009. In the office action the Examiner:

- rejected claims 82-89, 91, 92-96, 98, 99-105 and 107-111 under 35 U.S.C. 103(a) as being unpatentable over Moody et al. (US 2005/0144157, hereinafter "Moody") in view of Rohall et al. (US 2003/0163537, hereinafter "Rohall"); and
- rejected claims 90, 97 and 106 under 35 U.S.C. 103(a) as being unpatentable over Moody in view of Rohall, and further in view of Comer et al. ("Conversation-Based Mail," hereinafter "Comer").

The pending claims are claims 82-117. Claim 112-117 are new claims.

Related Applications

Office Actions and any Notices of Allowance in US Patent Applications 10/816,427, 10/914,034, 10/914,035, 10/914,036, and 10/914,040 may contain arguments or information relevant to the prosecution of this application. The Examiner is encouraged to review the Office Actions and any Notices of Allowance in the afore-mentioned applications, all of which are available on PAIR.

Amendments to Claims

Independent claims 82, 86, 93, 100, 102, 109, and 111 have been amended to recite that at least one of the conversation presented to a requestor as a single item includes multiple electronic messages and has an associated icon indicating the number of messages in the conversation.

Claims 83, 89, 96, 101, 105, and 110 have been amended to recite that the single item for a respective conversation presented to a requestor is generated so as to include a text string having a highlighted instance of at least one of the user-specified query terms.

Claims 112-117 have been added to recite that the single item for a respective conversation presented to a requestor includes a subject of the respective conversation and, in addition, a text string having a highlighted instance of at least one of the user-specified query terms.

Claim 84 has been amended to recite that the conversations are presented to a requestor in an order determined in accordance with a date/time value of a most recently received message of a respective conversation.

Claim 85 has been amended to recite that the conversations are presented to a requestor in an order determined, for each conversation, in accordance with a date/time value of a most recently received message that is relevant to the search query..

Claims 90, 97, and 106 have been amended to recite that at least one of the conversations comprises a plurality of electronic messages having a close temporal relationship with each other.

Claims 91, 98, and 107 have been amended to recite that the two or more messages within a conversation has substantially the same subject reference and at least another characteristic of the messages.

Support for these amendments is found, at least, in paragraphs [0052], [0055], [0056], [0076] and Figures 7B-7C of the present application.

No new matter has been added. With respect to all amendments, Applicants have not dedicated or abandoned any unclaimed subject matter. Moreover, Applicants have not acquiesced to any characterizations of the invention, nor any rejections or objections of the claims, made by the Examiner.

Claim Rejections under 35 USC §103

To establish prima facie obviousness of a claimed invention, all the claim elements must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Finding all the claim elements in the prior art is necessary, but not sufficient. *KSR Intern. Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007) ("a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art"). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

A. Rejection of Claims 82-89, 91, 92-96, 98, 99-105 and 107-111

Independent claim 82, as amended, recites a method for searching messages in a conversation-based message system, comprising:

on at a client having one or more processors and memory
storing programs executed by the one or more processors,
responding to receipt of a query from a requestor, the query
having one or more query terms, including:

transmitting the query over a network to a
conversation management system;

receiving from the conversation management system a list of conversations that match the one or more query terms, each of the conversations in the list having a respective conversation identifier, and wherein each conversation comprises one or more messages sharing a common set of characteristics that meet first predefined criteria and at least one conversation in the list of conversations comprises a plurality of messages; and

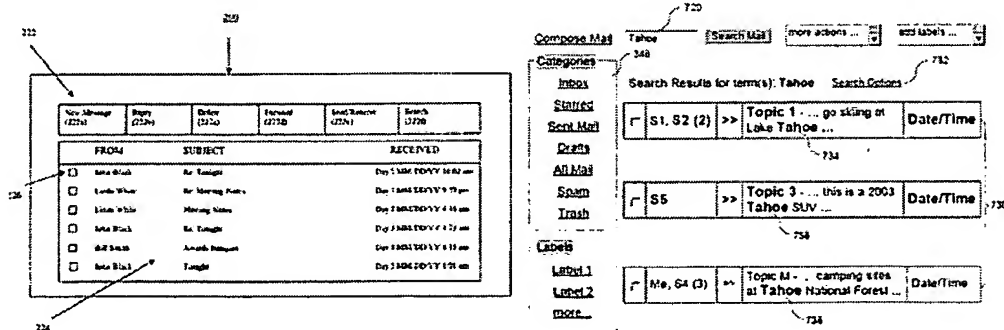
presenting at least a portion of the list of conversations to the requestor, each conversation listed in the presented portion of the list being represented as a single item, the presented portion of the list including a plurality of items, each representing a distinct conversation at least one of which comprises a plurality of messages wherein each item representing a conversation having a plurality of messages has an associated icon indicating the number of electronic messages in the conversation.

Emphasis Added.

1. Neither Moody nor Rohall discloses or suggests a display of an icon indicating the number of electronic messages within a conversation that includes a plurality of messages

Both Moody and Rohall are directed to system and method for providing enhanced features for an email system. Moody discloses a method for returning a message that matches a query along other messages belonging to the same thread. *Moody*, paragraph [0006]. Rohall discloses a method of forwarding an email conversation thread as single entity. *Rohall*, abstract.

For illustration, Figure 2 of Moody and Figure 7B of the present application are reproduced below side by side. In Figure 2, the incoming messages are displayed individually in an order based on their arrival times. Because the messages in Moody are displayed one item per line, there is no need for the user interface to include an icon indicating the message number, which is always one.



In contrast, claim 82 requires that the messages are organized into conversations. Each conversation is displayed as single item on the screen. *See, e.g., Figures 6D and 7C of*

the present application. If a conversation, which matches a search query, includes multiple messages, there is an icon displayed (in the item corresponding to the conversation, in the list of conversations) indicating the number of messages in the conversation. For example, Figure 7B above depicts that the first conversation includes two (2) messages and the third conversation include three (3) messages.

2. Neither Moody nor Rohall discloses or suggests a presentation of a plurality of distinct conversations, each conversation being represented as a single item in a list of conversations.

Although Moody discloses the feature of allowing the user to search for messages that include search terms and all related messages, it does not teach or suggest that the search results includes an icon indicating the number of related messages within a thread. In such case, Moody still displays only an initial message that might match a search query and hides the other related messages from the user. A user can expand the initial message to view the other related messages. *Moody*, paragraphs [0059] and [0060]. There is nothing in Moody's search result screenshot (Figure 2) that indicates the number of messages related to the initial message. In fact, Figure 2 is the only screenshot of Moody that illustrates how the email messages are displayed to an end user; none of the other screenshots (Figure 3-5) in Moody illustrate how email messages are displayed. Thus, the only email message display format taught by Moody is one message per line.

In contrast, claim 82 recites a presentation of a plurality of distinct conversations, each conversation being represented as a single item, and each having a respective conversation identifier. Each listed conversation has one or more messages, and at least one of the listed conversations includes a plurality of messages. Thus, even a single-message conversation of the present application is different from a message that occupies one line in Figure 2 of Moody because the conversation is associated with a unique conversation identifier.

Finally, none of the screenshots in Rohall are related to the display of email messages in response to a search query. Nor does the Examiner cite Rohall for such purpose.

In sum, because Moody and Rohall, separately or in combination, fail to teach or suggest at least one claimed feature of claim 82 and its dependent claims 83-85 and 112, claims 82-85 and 112 are patentable over a combination of Moody and Rohall. The Applicants respectfully request that this rejection be withdrawn.

Claim 86 recites a method implemented at a server for preparing a list of conversations, at least one of the conversations comprising two or more electronic messages and having an associated icon indicating the number of electronic messages in the conversation. Thus, claims 86-89, 91-92, and 113 are also patentable over a combination of Moody and Rohall for at least the same reasons as those explained above.

Claim 93 recites a server system. Claims 93-96, 98-99, and 114 are also patentable over a combination of Moody and Rohall for at least the same reasons as those explained above with respect to claim 86.

Claim 100 recites a client system. Claims 100-101 and 115 are also patentable over a combination of Moody and Rohall for at least the same reasons as those explained above with respect to claim 82.

Claim 102 recites a computer program product. Claims 102-105, 107-108, and 116 are also patentable over a combination of Moody and Rohall for at least the same reasons as those explained above with respect to claim 86.

Claim 109 recites a computer program product. Claims 109-110 are patentable over a combination of Moody and Rohall for at least the same reasons as those explained above with respect to claim 82.

Claim 111 recites a client system. Claim 111 is patentable over a combination of Moody and Rohall for at least the same reasons as those explained above with respect to claim 82.

B. Rejection of Claims 90, 97 and 106

Claims 90, 97, and 106 are dependent from claims 86, 93, and 102, respectively. As noted above, Moody and Rohall fail to disclose or suggest at least one claimed feature recited in claims 86, 93, and 102.

Comer, the third reference cited by the Examiner, discloses a conversation-based mail system. But it does not provide any teaching on how to display the conversations in response to a search request. Thus, claims 90, 97, and 106 are patentable over a combination of Moody, Rohall, and Comer for at least the reasons above.

Finally, it should be noted that, by responding in the foregoing remarks only to particular positions asserted by the Examiner in the office action dated February 20, 2009, Applicants do not necessarily acquiesce in other positions that have not been explicitly addressed in this amendment. In addition, Applicants' arguments for the patentability of a

claim should not be understood as implying that no other reasons for the patentability of that claim exist.

In light of the above amendments and remarks, the Applicant respectfully requests that the Examiner reconsider this application with a view towards allowance. The Examiner is invited to call the undersigned attorney at (650) 843-4000, if a telephone call could help resolve any remaining items.

Respectfully submitted,

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